

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD S. BICE, JON P. BRUSSEAU,
RICHARD L. LACOURSE, and HERBERT T. RAFFAELE

Appeal 2007-1865
Application 09/879,816
Technology Center 2100

Decided: December 11, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO
and ROBERT E. NAPPI, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 2 through 9, 14 through 20, 24 through 31, and 34 through 36. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a). Within these statutory provisions, we recognize that the Examiner has withdrawn a final rejection of record in the prosecution history of this application and instituted a subsequent Office action that was not final. As such, the claims are at least twice rejected within 35 U.S.C. § 134(a).

As best representative of the disclosed and claimed invention, representative independent claim 34 is reproduced below:

34. A network-based automated message handling system for initiating responses to messages transmitted through a network by application components, the system comprising:

- at least one customer-defined message handling rule;

- at least one service-based message handling rule;

- at least one common message handling rule; and

- a message handler configured to:

 - receive a message from an application component,

 - determine, based on a content of the received message, whether to apply the at least one customer-defined message handling rule,

 - determine, based on the content of the received message, whether to apply the at least one service-based message handling rule,

 - determine, based on the content of the received message, whether to apply the at least one common message handling rule,

 - identify at least one first party when the at least one customer-defined message handling rule applies to the received message,

 - identify at least one second party when the at least one service-based message handling rule applies to the received message,

 - identify at least one third party when the at least one common message handling rule applies to the received message, and

generate new messages to the identified at least one first party, the identified at least one second party, and the identified at least one third party.

The following references are relied upon by the Examiner:

Escolar	US 5,926,100	Jul. 20, 1999
Brown	US 6,631,363 B1	Oct. 7, 2003
		(Filing date Oct. 10, 2000)
Teegan	US 6,748,555 B1	Jun. 8, 2004
		(Filing date Sept. 9, 1999)

Claims 3 through 8, 14, 15, 20, 24 through 28, and 34 through 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Brown in a first stated rejection. This reference is utilized within 35 U.S.C. § 103 alone to reject claims 17 through 19 in a second stated rejection. Teegan is combined with Brown within 35 U.S.C. § 103 as to claims 2, 16, and 29 through 31 in a third stated rejection. Lastly, Escolar is combined with Brown within 35 U.S.C. § 103 in a fourth stated rejection as to claims 9 and 20.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as amplified here, we sustain each of the four separately stated rejections of the claims on appeal. Within the first stated rejection Appellants commonly argue independent claims 34 and 35, with independent claim 34 as representative,

at pages 7 through 12 of the principal Brief on appeal while independent claim 36 is separately argued at pages 14 through 18 of this Brief. Separate arguments are also presented with respect to dependent claim 8. Of the remaining dependent claims on appeal, they will be treated in turn.

At the outset, it appears to us that the subject matter presented in all claims on appeal relates to feature that may differ from the prior art solely on the basis of “non-functional descriptive material,” which is generally not given patentable weight when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack* 703 F.2d at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 209 USPQ 1, 10 (1981). However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See in re Lowry*, 32 F.3d 1579, 1583-84, (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, (Fed. Cir. 2004). We conclude that when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. That is, we conclude that such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

In the instant case on appeal, we find that the invention of all claims on appeal recites non-functional descriptive material which does not provide a patentable distinction to the data or to the process of the claimed methods.

In other words, we find that the meaning relating to the types or categories of messages such as the customer-defined messages, the service-based messages and the common messages of independent claims 34 through 36, the label attached to software faults and various types of recipients of messages or labels of them can not be used to distinguish the claimed invention from prior art approaches. Therefore, we conclude the invention of all claims on appeal is not patentably distinguishable from the teachings of the applied prior art.

In this latter regard, we, and the artisan, would plainly read the teachings of Brown as applying to any and all systems and/or environments of use. This can be derived from a general understanding of the written description in conjunction with the generic teachings of Brown. This concept of general applicability is expressly stated at column 2, lines 28 through 36 of this reference. The overall systems environment of Brown is shown in figures 1 and 2, and the use of general rules within the alert manager 24 in these figures are shown in figure 5 with selectability of various notifications or message generations that occur to various users is also depicted in this latter figure. The general functions of receiving types of messages are inclusive within the event router 16 of figures 1 and 2 and the various determinations and identifications of what to do once these messages are received are in the context of the functional operations described in Brown as to this event router as well as the event handlers 20.

Moreover, it appears that significant teachings and showings exist in Brown that has not been fully appreciated by the Examiner as well as the Appellants. The various types of alert notifications contemplated in Brown

are initially introduced in the last sentence of the abstract. The Examiner has pointed out in the Answer that Brown at the bottom of column 5 describes the utilization of a pager and email systems. More significantly, however, are the generic teachings beginning at column 6, line 59 through the end of the Brown patent that relate to the customer interface portal of Appellants' exemplary claims 3, 4, 8, 9, and 20. Further, the teachings identify that there is user selectability of the nature of the notice as well as the nature of the recipient through conventional menu choices, templates and the ability to utilize well known delivery methods which relate to the features of dependent claims 17 through 19.

We make separate note as to those notified of a fault in dependent claims 2, 16, and 29, for example, who, within Brown's application 12, may be considered to be customers as well as users 28 in the context of the overall teachings of Brown. Figure 4 also illustrates various types of events which are categorized as well as separate identifiable recipients for each type even as indicated at the very bottom of column 2 of Brown; a user may be another application 12.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1996). "[T]he Examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.3d 1443, 1445, (Fed. Cir. 1992). Furthermore, "there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness' [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006)).

Our earlier remarks have directly addressed the requirements of dependent claims 17 through 19 rejected under 35 U.S.C. § 103 over Brown alone. The Examiner’s reasoning of combinability with respect to the other remaining dependent claims in the third and fourth stated rejections, respectively relying upon Teegan and Escolar, appear to us to comply with the requirements of the above-noted case law. Moreover, we generally agree with the Examiner’s observations with respect to Teegan and Escolar that they are properly considered to be analogous art since they present to the artisan other network-based automatic message handling systems. Moreover, because of our earlier remarks with respect to Brown alone, this reference is much more comprehensively teaching the nature of the subject matter of the claims in the third and fourth stated rejections than the Examiner appears to have realized.

The Examiner’s additional reliance upon “Official Notice” with respect to the stated rejection of claims 17 through 19 at pages 6 and 7 of the Answer is misplaced. The additional teachings we already identified earlier in this opinion directly relate to the features recited in these claims. The utilization of the “Official Notice” approach is generally disfavored.

Moreover, the Examiner's additional reliance upon a new patent to Wagner at page 13 of the Answer, apparently utilized in response to Appellants' corresponding remarks in the principal Brief on appeal, is also misplaced. The Wagner patent is not of record and has not been relied upon by the Examiner in the statements of the rejection of the claims from which Appellants have appealed. As such, we have not considered its teachings in our deliberations, notwithstanding Appellants' responsive comments with respect to this new reference at pages 7 and 8 of the Reply Brief.

To the extent the principal Brief invites us to read into the claims subject matter from the Specification to distinguish over the teachings and suggestions of the applied prior art, we decline to do so. This approach is not persuasive of patentability. It is the teachings of the applied prior art, their nature and extent, that lead us to conclude that the claims on appeal are anticipated and/or would have been obvious rather than any specific environment of use of the applied prior art. Our affirmance of the four stated rejections of the claims on appeal is based alternatively upon both considering and not considering as positive recitations the nature of the non-functional descriptive material noted earlier as recited in the claims on appeal.

Lastly, in recognizing that there is no stated rejection before us of the claims on appeal within 35 U.S.C. § 101, it appears to us that to the extent any future prosecution may occur with respect to this application, the nature of the presently claimed subject matter clearly gives rise to this issue. The claimed application components and the various rules directly relate to software entities and/or abstract concepts or computer instructions per se.

The claimed process of independent claims 35 as well as the system of independent claim 34 are respectively software logic processes and software systems which appear to directly relate to the flow chart approaches broadly set forth in disclosed figures 7 and 10. Additionally, the medium of independent claim 36 is not stated to be a tangible medium and this claim appears to directly recite program instructions per se. The directly recited handler in independent claim 34 is not recited at all in independent claim 35 but is passively recited in independent claim 36. This handler is stated in the Specification at page 10, lines 4 through 20 to be a software device. Off the shelf software packages were stated to have been utilized in the embodiment of the presently claimed invention beginning at the bottom of Specification page 38 where standard message formats known in the art were recognized at page 39 to be utilized. Also, the discussion at the bottom of page 11 of the Specification indicates that a prior art software package appears to be utilized to embody the claimed handler.

Thus, it is apparent that during any future prosecution, the nature of the disclosed and claimed subject matter may give rise to rejections under 35 U.S.C. § 101 and appropriate art rejections based upon what has been admitted to have been utilized from the prior art.

In view of the foregoing, the decision of the Examiner rejecting various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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